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D. REMARKS

Specification

Applicants have amended the specification to update the status of a cross-referenced patent application.

Status Claims

Claims 1-54 are pending in the application. Claims 30, 37, and 44 are currently amended.

Interview Summary

Multiple telephone interviews were conducted between Applicants' Representative Amy Pattillo and Examiner Ubiles. No exhibits were shown, nor demonstrations conducted.

The following issues were discussed:

- (1) Applicants requested clarification of the rejection the amended element of "wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue" in claim 1. Applicants note that the Examiner includes two statements of "what would have been obvious to one of ordinary skill" – one on page 2 of the rejection and the next on page 3 of the rejection. Applicants request clarification of which statement the Examiner relies on to support the 103(a) rejection. The Examiner initially responded that both statements of obviousness apply and that the first statement applies to the incentive to voice browse and the second statement goes towards the incentive happening before, on a previous call.
- (2) In the first office action, dated June 4, 2004, The Examiner rejected claims 30-31, 34-36, 37-38, 41-43, 44-45, and 48-49 under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (US Patent Number 6,178,240) in view of Saylor et al. (US 6,263,051). In the current office action, dated January 21, 2005, the Examiner rejects these claims only under 103(a) in view of Walker et al. (6,178,240) alone. Applicants note that in the current office action, the Examiner states that the June 4 office action taught that "the

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caller may select his or her preferred website from a list provided by Walker's system" and that this teaches "specifying a voice XML script according to said caller profile, such that voice browsing while waiting in said hold queue is specified by said caller."

Applicants note, however on page 8 of the June 4 office action the Examiner specifically stated that Walker does not teach "specifying a voice XML script according to said caller profile, such that voice browsing while waiting in said hold queue is specified by said caller." Applicants requested clarification of the Examiner's reasoning for changing the interpretation of the scope of Walker and the scope of the claim language. The Examiner responded that in a second review of Walker, the Examiner concluded that Walker uses voice scripting and that voice XML is just one type of script that could be used for voice ACD. Applicants determined to clarify the claim to overcome any disclosure by Walker of selecting a preferred voice script for a caller.

In conclusion, no agreements were reached during the interview. Applicants file the following response for reconsideration by the Examiner

In an email communication on April 13, 2005, Applicants requested clarification of the grounds of rejection of claims 2, 12-14, and 23-25. The Examiner responded on April 14, 2005 in an email communication that the heading to the first claim rejection on page 2 of the Office Action should read "claims 1-3, 5, 12-14, 16, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 6, 178,240), as per the reasons set forth in the Office Action mailed 6/4/2004." In a telephone conversation on April 14, 2005, Applicants requested clarification of whether claims 2, 12-14, and 23-25 were rejected under the same new grounds as claims 1, 3, 5 and 16. The Examiner responded that because claims 2, 12-14, and 23-25 were rejected for the same reasons as claims 1, 3, 5, and 16 in the Office Action dated 6/4/2004, they were also rejected for the same reasons as these claims in the most recent office action dated 1/21/2005.

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Claim Rejections - 35 USC § 103(a)

1. Claims 1-3, 5, 12-14, 16, and 23-25 are not obvious under Walker et al.

Claims 1-3, 5, 12-14, 16, and 23-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (US Patent Number 6,178,240) (hereinafter also referred to as Walker). The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. As previously amended, claims 1-3, 5, 12-14, 16, and 23-25 are not obvious under Walker and therefore the rejection should be withdrawn and the claims allowed.

Claims 1, 12, and 23

With regards to claims 1, 12, and 23, independent method claim 1, which is representative of independent system claim 12 and independent computer program product claim 23, with regard to similarly recited subject matter and rejection, reads as follows:

1. **(Previously Amended)** A method for promoting voice browsing, comprising:
 - selecting at least one web page from among a plurality of accessible web pages for voice browsing by a particular caller waiting in a hold queue; and
 - offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue.

In the rejection of claims 1 and 3, the Examiner states that “previously claimed limitations are rejected for the same reasons as stated in the Office Action mailed 6/4/2004.” [Office Action, p. 2] In addition, the Examiner states that

“in regards to the newly introduced limitations that receive “an incentive to voice browse...” and “wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue”, reads on the teachings of Walker et al. regarding the use of a flag on the customer profile indicating the denial of complimentary entertainment options to fraudulent customers (See, for example, col. 2, lines 3-14).” [Office Action, p. 2]

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Applicants note that the Examiner previously rejected selecting at least one web page from among a plurality of accessible web pages for voice browsing by a particular caller waiting in said hold queue under the abstract, lines 1-3 and col. 6, lines 12-32 of Walker. [Office Action dated 6/4/2004, p. 2]

Next, in the most recent office action of 1/21/2005 the Examiner states that

“it would have been obvious to one of ordinary skill that returning preferred customers will be offered complimentary paid entertainment services (i.e. voice web browsing) on subsequent calls to the call center, their good standing is reflected on the caller profile. The claimed “value redeemable in a transaction independent of said particular caller waiting in said hold queue” reads, for example, in a complimentary service offered to a returning customer in good standing (i.e. with no flag). As taught by Walker et al., the complimentary service is denied to customers who have previously made fraudulent usage, the term “previously” implies a past transaction, therefore; it would have been obvious to one of ordinary skill that the decision to offer the complimentary service was based on an independent transaction performed by the customer currently in a hold queue. The limitation stating that “an incentive” is offered “to voice browse” reads on the implied action of the caller accepting the complimentary service.” [Office Action, pp.2-3]

Applicants note that during the interview, Applicants’ representative noted that the Examiner includes two different statements of what “would have been obvious to one of ordinary skill” and requested clarification of which statement the Examiner relies on to support the 103(a) rejection. The Examiner responded that both statements are statements as to obviousness, and in particular stated that one statement goes to the incentive to voice browse element and the other statement goes to the incentive happening before, on a previous call. In addition, Applicants note that the Examiner cites col. 2, lines 3-14 as teaching the use of a flag on a customer profile indicating the denial of complimentary entertainment options to fraudulent customers, however, actually col. 8, lines 10-22 refer to the flag on a customer profile set to indicate whether to allow the customer access to entertainment options.

Additionally, in response to the arguments, the Examiner states the following response to Applications previous argument that the rejection of claim 1 is not correct:

Regarding claims 1-4, 9, 12-15, 20, 23-26, the Applicant argues that Walker et al. (‘240) “merely teaches offering the complimentary service, but does
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not teach offering a redeemable incentive for the user waiting on hold to use the complimentary service". Claims are rejected for the reasons discussed in the body of the rejection above. Further, Examiner respectfully disagrees with the definition of "incentive" as explained by Application in page 21 of Amendment dated 9/7/2004. The Applicant note that "incentive" does not equate offering a "complimentary service". The word "incentive" is defined as "a reward [something given or received in recompense for worthy behavior]" (See The American Heritage College Dictionary, 4th Ed) and "complimentary" as "[something] given free to repay a favor"; in Walker's system, the "complimentary service" is offered to customers in good standing (i.e. not flag), therefore as means to reward customer's previous actions." [Office Action, pp. 7-8]

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not carry the burden of proving a prima facie case of obviousness as to claim 1 for the following reasons.

Walker et al does not teach or suggest all the limitations of Claim 1

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue.

First, Walker does not teach offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue because Walker and the

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Examiner only discuss setting a flag in a customer profile to determine whether to offer the caller a particular service while the caller is waiting in a hold queue, but the present invention teaches an incentive that is redeemable outside the caller waiting in the hold queue. In particular, the Examiner cites "an incentive to voice browse" and "wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue" as reading on the disclosure in Walker of a flag field in a customer account that is set to indicate what type of access to offer the caller to entertainment services, if access is offered. [Office Action, p. 2] The Examiner does not cite what element of claim 1 is not taught by Walker, but then cites two different rationales for why the amended claim elements would be obvious in view of Walker's teaching of a flag field. [Office Action, pp. 2, 3] In both of the rationales, the Examiner concludes that it would be obvious based on Walker's teaching of a flag system to track whether a customer is fraudulent or good, to offer customers in good standing with complimentary services while on hold in future calls, but not to offer that service to customers waiting on hold who have previously abused the complimentary service while on hold. [See Office Action, pp. 2, 3] In particular, in the second statement of obviousness, the Examiner concludes that "the complementary service is denied to customers who have previously made fraudulent usage, the term "previously" implies a past transaction" and based on this conclusion as to the implied teaching of Walker states that "it would have been obvious to one of ordinary skill that the decision to offer the complimentary service was based on an independent transaction performed by the customer currently in a hold queue." [Office Action, p. 3] Fraudulent usage, however, as taught by Walker col. 8, lines 10-22, is based on whether a caller has previously made fraudulent usage of the complimentary entertainment services while on hold by calling the call center by being placed on hold merely to access complimentary paid entertainment options during the hold period and then hanging up when the attendant becomes available. Thus, the Examiner's assertion that "previously" of "previously made fraudulent usage" implies a "past transaction" is erroneous because Walker specifically teaches previously made fraudulent usage occurs because a caller only waits in the hold queue to access the complimentary paid entertainment services. In addition, regardless of whether the Examiner's

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assertion as to the implications of Walker's teaching is erroneous, neither Walker et al. nor the Examiner's assertion as to what would be obvious in view of Walker based on the Examiner's assertion as to what Walker implies, teaches an incentive with a redeemable value in a transaction independent of the caller waiting in the hold queue. Walker et al.'s teachings and the Examiner's assertion as to what would have been obvious are both limited to offering a caller a complimentary service while the caller is on hold; neither teach a redeemable incentive received as a response to agreeing to voice browse that is redeemable independent of the hold queue or a flag set responsive to a caller's performance outside of the caller waiting in the hold queue. In contrast, the present invention teaches that a caller is currently offered an incentive to browse, where the incentive has a redeemable value in a transaction independent of when the caller waits in the hold queue.

Second, Walker does not teach offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue because Walker does not teach or imply both offering the caller the voice browsing service and offering the caller an incentive to voice browse with a redeemable value in a future transaction independent of when the caller waits in the hold queue. In particular, Walker discloses offering callers waiting on hold access to paid entertainment services. *Walker*, Abstract and col. 2, lines 17-52. Thus, Walker teaches offering a service to a caller on hold. Some callers may be offered complimentary access to the paid entertainment services. *Walker*, col. 2, lines 40-45. Thus, Walker may teach offering an incentive to the caller to use the service, where that incentive is that the service is free. Walker does not teach both offering an entertainment service to callers on hold and offering an incentive to use the service to callers on hold, where the incentive has a redeemable value in a future transaction independent of the caller waiting in the hold queue. In contrast, the present invention teaches offering a voice browsing service to a caller on hold and offering an incentive to the caller to use the voice browsing service while on hold, where the incentive has a redeemable value in a future transaction independent of the caller waiting in a hold queue.

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In conclusion, a prima facie case of obviousness under 103(a) is not established for claim 1 because at least one element of claim 1 is not taught by Walker. Because a prima facie case of obviousness under 103(a) is not established for the claim 1, Appellants respectfully request allowance of claims 1, 12, and 23.

There is no suggestion or motivation to modify Walker

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Walker must come from the teachings of Walker, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Applicants respectfully note that the Examiner does not show, nor does Walker teach, a suggestion or motivation to modify Walker to teach offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue.

Walker discloses a call center where a caller is provided access to paid entertainment services while on hold. *Walker*, Abstract and col. 2, lines 17-52. Particular callers may be provided complimentary access to the paid entertainment services. *Walker*, col. 2, lines 40-45. The Examiner’s statements as to what would have been obvious to one of ordinary skill in view of Walker’s teaches focus on a call center determining whether to offer complimentary access to paid entertainment services to a caller on hold in the future based on the performance of the caller while on hold in the past. [See Office Action, pp. 2, 3]. The Examiner asserts that “previously” in Walker’s teaching of “previously made fraudulent usage” implies a past

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transaction. As previously asserted, any past transactions by a user that are labeled as “previously made fraudulent usage” are expressly taught by Walker as the previous use, by a caller waiting on hold, of complimentary paid entertainment services, followed by the caller hanging up when an attendant is available to take the call. [Office Action, p. 3] Neither Walker nor the Examiner disclose, however, a teaching that suggests modifying Walker to both provide access to complimentary paid services to a caller waiting on hold and provide an incentive to use the service, where the incentive has a redeemable value in a future transaction independent of the caller waiting in the hold queue. Therefore, because there is no suggestion or motivation in the teachings of Walker or cited by the Examiner, to modify Walker to teach offering an incentive with a redeemable value in a transaction independent of the caller waiting in the hold queue, a prima facie case of obviousness is not established in view of Walker for claim 1 and Applicants respectfully request allowance of claim 1, 12, and 23.

There is No Reasonable Expectation of Success in the Proposed Modification of Walker

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Walker. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Applicants respectfully assert that there is no reasonable expectation of success in the proposed modification of Walker, where the proposed modification is what the Examiner states would be obvious to one with skill in the art in view of Walker. Claim 1 teaches that a web page to offer to a particular caller to voice browse is selected and that the call center not only offers the caller access to the voice browsing of those web pages, but offers the caller an incentive to voice browse the pages, where the incentive has a redeemable value in a future transaction outside the caller waiting in the hold queue. The Examiner’s explanation of what is obvious in view of Walker is a call center that offers an entertainment service to callers on hold and determines whether a caller is offered the service on a complimentary basis while currently on hold based on the caller’s previous use of the complimentary paid service while previously on hold. [See Office Action, pp. 2, 3] There is no indication that Walker, or what would be obvious to one skilled in the art in view of Walker,

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teaches said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue. Thus, there is no reasonable expectation of success in the proposed modification of Walker and therefore no prima facie case of obviousness as to claim 1. Therefore, because there is no prima facie case of obviousness as to claim 1, Applicants respectfully request allowance of claims 1, 12, and 23.

Claims 2-3, 5, 13-14, 16, 24-25

Regarding claims 2-3, 5, 13-14, 16, and 24-25, Applicants respectfully proposes that because the independent claims 1, 12, and 23 upon which these dependent claims rely are not obvious in view of Walker, then these dependent claims are also not obvious in view of Walker and the dependent claims should be allowed.

In addition, with regards to claims 5 and 16, dependent method claim 5, which is representative of dependent system claim 16, with regard to similarly recited subject matter and rejection, reads as follows:

5.(Original) The method for promoting voice browsing according to claim 1, wherein said incentive comprises at least one from among an on hold advancement token, membership points, an electronic discount, and a cash value.

The Examiner rejects claims 5 and 16 on the ground that “said incentive comprising at least membership points” reads for example on a returning customer in good standing able to use the complimentary service, offering “complimentary service” to a returning customer, for example, in well-known preferred customer programs. [Office Action, p. 3]

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants respectfully note that the Examiner does not show, nor do the references teach or suggest,

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separately or in combination, an incentive, wherein said incentive has a redeemable value in a transaction independent of the caller waiting in the hold queue, comprising membership points.

As to the Examiner's assertion that "offering complimentary service" to a returning customer, for example in well-known preferred customer programs" teaches "said incentive comprising at least membership points", Applicants respectfully request that the Examiner provide documentary support for this statement of "common knowledge". The Examiner merely states that offering complimentary service to a returning customer is supported by well-known customer programs, but does not provide any documentary evidence of the well-known nature of the use of voice recognition. Therefore, Applicants request that if the rejection is to be maintained on these grounds that the Examiner provide documentary evidence of the basis of the assertion of what is well known in the art in the next Office Action. MPEP 2144.03, 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test.)

However, regardless of whether providing complimentary services based on customer programs are well-known, Walker combined with customer programs does not teach an incentive comprising membership points. Applicants note that the incentive, as previously asserted with regard to claim 1, has a redeemable value in a transaction independent of the caller waiting in the hold queue. The complimentary service, and thus any customer program, described in Walker is one that is only available to a caller in a hold queue. Therefore, Applicants respectfully disagree with the Examiner's statement in the office action that "said incentive comprising at least membership points" reads "for example on a returning customer in good standing able to use the complimentary service", because the complimentary service disclosed in Walker is one that is only available to the caller while on hold and the incentive is specified as redeemable in a transaction independent of the caller waiting in the hold queue. In conclusion, a prima facie case of obviousness under 103(a) is not established for claim 5 because at least one element of claim 1 is not taught by Walker in view of customer programs. Because a prima facie case of

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obviousness under 103(a) is not established for the claim 5, Appellants respectfully request allowance of claims 5 and 16.

2. Claims 4, 6-8, 10-11, 15, 17-19, 21-22, 26-29, 50-54 are not obvious under Walker et al

Claims 4, 6-8, 10-11, 15, 17-19, 21-22, 26-29, and 50-54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (US Patent Number 6,178,240). The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Because the Examiner does not carry the burden of proving a prima facie case of obviousness for claims 4, 6-8, 10-11, 15, 17-19, 21-22, 26-29, and 50-54, the rejection should be withdrawn and the claims should be allowed.

The Examiner states, in the most recent Office Action dated 1/21/2005, that claims 4, 6-8, 10-11, 15, 17-19, 21-22, 26-29, and 50-54 are rejected under 35 USC 103(a) as being unpatentable over Walker "as per the reasons set forth in the Office Action mailed 6/4/2004. [Office Action, p. 3]

First, regarding claims 4, 6-8, 10-11, 15, 17-19, 21-22, and 26-29, Applicants respectfully assert that because the independent claims 1, 12, and 23 upon which these dependent claims rely are not obvious in view of Walker, then these dependent claims are also not obvious in view of Walker and the dependent claims should be allowed.

Next, Applicants present the following arguments as to the lack of prima facie obviousness for the following claims.

Claims 6-8, 17-19, 27-29, 50-54

Claim 50 currently reads as follows:

50. (Original) A method for controlling voice browsing, comprising:
receiving a call for a caller with an authenticated identity at a hold queue;
accessing a caller profile stored in association with said authenticated identity, wherein said caller profile indicates at least one web page visited by said caller; and

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selecting at least one web page from among a plurality of accessible web pages other than said at least one web page visited by said call for voice browsing by a particular caller waiting in a hold queue.

Previously, the Examiner rejected claims 50 with grounds for the rejection and rejected claims 6-8, 17-19, 27-29, 52, and 54 for the same reasons as claim 50. [Office Action dated 6/4/2004, pp. 5, 6] In particular, as to receiving a call for a caller with an authenticated identity at a hold queue, the Examiner cited Walker as teaching “a customer account database that maintains a plurality of records, each associated with a different customer, the customer account database includes the customer’s address and telephone number” based on col. 7, line 66-col. 8 line 4 which reads:

“The customer account database 300 maintains a plurality of records, such as records 310-312, each associated with a different customer. For each customer name listed in field 320, the customer account database 300 includes the customer’s address in field 325 and telephone number in field 330.” [Office Action dated 6/4/2004, p. 4]

Applicants previously argued that the Examiner did not establish a case of prima facie obviousness because Walker does not teach receiving a call for a caller with an authenticated identity at a hold queue. In particular, Applicants argued:

Thus, the Examiner equates a telephone number with an authenticated identity of the caller. A telephone number, however, merely identifies the line number from which a call is placed and does not accurately identify the person placing the call using the telephone service associated with the line number. In contrast, authentication identifies the actual identity of the caller. The specification of the present invention further supports the distinction between a telephone number and an authenticated identity of a caller; p. 14, lines 20-27 of the specification describe an authentication service that includes identification and verification of the identity of a caller of a particular call. Thus, the Examiner does not specifically point out how Walker or any combination of Walker and another prior art reference teaches or suggests all the claimed limitations. [Response dated 9/7/2004, p. 24]

In the most recent office action dated 1/21/2005, The Examiner states:

As for claims 6-8, 17-19, 27-29, 50, 52, and 54, Applicant argues that the Walker et al. (‘240) merely “identifies the line number from which a call is placed and does not accurately identify the person placing the call using the telephone

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service associated with the line number.” Examiner respectfully disagrees with Applicant’s argument.

Based on authentication of an ANI and dialed number identification service (DNIS) for a call, a user identity can be recognized and based on the outcome can be either approved or denied a service (i.e. a credit card activation may be performed from a customer’s telephone number residing in a database, the telephone number is used to authenticate the customer). [Office Action, p. 8]

First, Applicants note that the Examiner disagrees with Applicant’s argument because “based on authentication of an ANI and dialed number identification service (DNIS) for a call, a user identity can be recognized and based on the outcome can be either approved or denied a service (i.e. a credit card activation may be performed from a customer’s telephone number residing in a database, the telephone number is used to authenticate the customer).” The Examiner does not provide a supporting reference for this argument. Applicants respectfully assert that the Examiner is relying on authenticating a customer based on a telephone number for credit card activation grounds for the rejection as “common knowledge” that Applicants respectfully request that the Examiner provide documentary support for this statement of “common knowledge”. Applicants request that if the rejection is to be maintained on these grounds that the Examiner provide documentary evidence of the basis of the assertion of what is “common knowledge” in the next Office Action. MPEP 2144.03, 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test.) Additionally, Applicants request that if the Examiner is relying on the credit card authentication knowledge as support for the rejection of the cited claims, that the Examiner explicitly show what teaching in Walker suggests or motivates the combination of Walker with the credit card authentication knowledge.

Second, Applicants continue to respectfully assert that Walker et al. does not teach receiving a call for a caller with an authenticated identity at a hold queue and therefore no prima facie case of obviousness is established for claim 50. In particular, Applicants assert that the Examiner’s argument still does not show how Walker teaches an “authenticated identity” of a caller. The Examiner cites an example, of credit card activation, where a telephone number is AUS920010826US1

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used to authenticate the customer based on matching an incoming call telephone number with a customer telephone number in a database. Applicants note, however, that a telephone number may be accessible to multiple callers, and therefore that detection of a telephone number, even if matched with a telephone number residing in a database, only identifies that a telephone number registered by a customer was used, and not that the caller on the line is the customer. For example, many different employees may place calls where the outgoing telephone number is a single number, and thus the telephone number only identifies the business, not the actual identity of the caller placing the call. Thus, telephone number based caller identification does not teach authenticating an actual identity of a caller and then accessing that caller's specific profile. In conclusion, a prima facie case of obviousness under 103(a) is not established for claim 50 because at least one element of claim 50 is not taught by Walker in view of customer programs. Because a prima facie case of obviousness under 103(a) is not established for the claim 50, Appellants respectfully request allowance of claims 6-8, 17-19, 27-29, 50, 52, and 54

Regarding claims 51 and 53, Applicants respectfully assert that because the independent claims 50 and 52 upon which these dependent claims rely are not obvious in view of Walker, then these dependent claims are also not obvious in view of Walker and the dependent claims should be allowed.

3. Claims 9 and 20 are not obvious under Walker et al.

Claims 9 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Walker in view of Uppaluru (US Patent 5,925,001). Applicants respectfully assert that because the independent claims 1 and 12 upon which these dependent claims 9 and 20 rely are not obvious in view of Walker, then the dependent claims 9 and 20 are also not obvious in view of Walker and the dependent claims should be allowed.

4. Claims 30-31, 34-36, 37-38, 41-43, 44-45, and 48-49 are not obvious under Walker et al.

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Claims 30-31, 34-36, 37-38, 41-43, 44-45, and 48-49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (US Patent Number 6,178,240). The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Because the Examiner does not carry the burden of proving a prima facie case of obviousness for claims 30-31, 34-36, 37-38, 41-43, 44-45, and 48-49, the rejection should be withdrawn and the claims should be allowed.

Claims 30, 37, 44

With regards to claims 30, 37, and 44, independent method claim 33, which is representative of independent system claim 37 and independent computer program product claim 44, with regard to similarly recited subject matter and rejection, reads as follows:

30. **(Currently Amended)** A method for specifying voice browsing, comprising:
- receiving a call for a caller with an authenticated identity at a hold queue;
 - accessing a caller profile stored in association with said authenticated identity; and
 - specifying at least one output attribute of a voice XML script according to said caller profile, such that voice browsing of said voice XML script while waiting in said hold queue is specified for said caller.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants respectfully note that the Examiner does not show, nor does the reference teach or suggest, receiving a call for a caller with an authenticated identity at a hold queue or specifying at least one output attribute of a voice XML script according to said caller profile, such that voice browsing of said voice XML script while waiting in said hold queue is specified for said caller.

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First, as to the element of receiving a call for a caller with an authenticated identity at a hold queue, the Examiner states:

Walker et al. discloses a customer account database that maintains a plurality of records, each associated with a different customer, the customer account database includes the customer's address and telephone number (i.e. receiving a call for a caller with an authenticated identity at a hold queue, as read on having a customer's account database including a telephone number) (See Description, col. 7, line 66-col. 8, line 4); [Office Action, p. 4]

Applicants note that col. 7, line 66-col. 8 line 4 cited by the Examiner in support of an "authenticated identity" discloses:

"The customer account database 300 maintains a plurality of records, such as records 310-312, each associated with a different customer. For each customer name listed in field 320, the customer account database 300 includes the customer's address in field 325 and telephone number in field 330."

In addition, Applicants note the previous arguments as Walker's lack of teaching of an "authenticated identity" in relation to claim 50. Applicants respectfully assert that Walker teaches telephone number identifier, not caller identity identification, and not authentication of the caller identity, not just the telephone number from which a caller is received. Further, merely matching an incoming call telephone number with a name associated with the telephone number in a database does not identify the actual identity of the caller or authenticate that identity. In contrast, the present invention teaches receiving a call for a caller with an authenticated identity and accessing the profile associated with the actual caller, not merely the telephone number of the incoming call. Therefore, Walker et al. fails to teach receiving a call for a caller with an authenticated identity at a hold queue.

Second, as to the element of specifying at least one output attribute of a voice XML script according to said caller profile, such that voice browsing of said voice XML script while waiting in said hold queue is specified for said caller, the Examiner stated:

Walker et al. discloses that the caller may voice browse the Web. Further, as per Walker's teachings, the customer may be denied access to a "complimentary service" based on information residing on his or her records, thus waiting on hold is limited by the information

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contained in his or her records; the caller, as previously discussed in Office Action mailed on June 4, 2005, may select his or her preferred website from a list provided by Walker's system (i.e. specifying a voice XML script according to said caller profile, such that voice browsing while waiting in said hold queue is specified by the caller). [Office Action, p. 4]

Walker teaches that a caller may select a preferred website from a list; Applicants have amended the claim to clarify that an output attribute of the voice XML script is specified, not merely that one of the caller's preferred websites is selected. In particular, the specification describes that, for example, a voice XML script may include an output attribute where a caller's actual name is inserted in the script. (Specification, p. 32, lines 13-22). As a result, in view of the amendments made for purposes of clarification, Walker fails to teach specifying output attributes of a voice XML script according to a caller profile.

In conclusion, a prima facie case of obviousness under 103(a) is not established for claim 30 because at least one element of claim 30 is not taught by Walker or obvious to one of ordinary skill in view of Walker. Because a prima facie case of obviousness under 103(a) is not established for the claim 30, Appellants respectfully request allowance of claims 30, 37, and 44.

Claims 31, 34-36, 38, 41-43, 45, and 48-49

In regards to claims 31, 34-36, 38, 41-43, 45, and 48-49, Applicants respectfully assert that because the independent claims 30, 37, and 44 upon which these dependent claims rely are not obvious in view of Walker, then dependent claims 31, 34-36, 38, 41-43, 45, and 48-49 are also not obvious in view of Walker and the dependent claims should be allowed.

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5. Claims 32, 39, and 46 are not obvious under Walker et al. ('240) in view of Walker et al. ('467)

Claims 32, 39 and 46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Walker as applied to claims 30-31, 34-36, 37-38, 41-43, 44-45, and 48-49, and further in view of Walker et al. (US Patent 5,978, 467). Applicants respectfully assert that because the independent claims 30, 37, and 44 upon which these dependent claims 32, 39, and 46 rely are not obvious in view of Walker, then the dependent claims 32, 39, and 46 are also not obvious in view of Walker and the dependent claims should be allowed.

In addition, The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Because the Examiner does not carry the burden of proving a prima facie case of obviousness for claims 32, 39, and 46, the rejection should be withdrawn and the claims should be allowed.

Dependent method claim 32, which is representative of dependent system claim 39 and dependent computer program product claim 46, with regard to similarly recited subject matter and rejection, reads as follows:

32. (Original) The method for specifying voice browsing according to claim 30, further comprising:
 authenticating said identity of said caller at a switching network
 transferring said call to said hold queue.

The Examiner cites the combination of Walker ('240) et al as teaching the system claimed except for "authenticating said identity of said caller at a switching network transferring said call to said hold queue." [Office Action, p. 5] The Examiner cites Walker ('467) as teaching that an incoming caller's telephone number can be detected by an automatic number identification (ANI) facility. [See Office Action, p. 5] The Examiner concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker et al ('240) system by adding the step of detecting the incoming call by an automatic number identification (ANI) facility" as teaching "authenticating said identity of said caller at a switching network transferring said call to said hold queue" and further concludes that

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“in this manner allow the system to start a caller profile based on the caller’s telephone number.
[Office Action, p. 6]

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). As previously discussed with reference to claims 30 and 50, the Examiner equates detecting an incoming call telephone number with authenticating an actual identity of the caller. A telephone number, however, merely identifies the line number from which a call is placed and does not accurately identify the actual person placing the call using the telephone service associated with the line number. In contrast, authentication identifies the actual identity of the caller. The specification of the present invention further supports the distinction between a telephone number and an authenticated identity of a caller; p. 14, lines 20-27 of the specification describe an authentication service that includes identification and verification of the identity of a caller of a particular call. Thus, the Examiner does not specifically point out how Walker or any combination of Walker and another prior art reference teaches or suggests the claimed limitation of “authenticating said identity of said caller.” In conclusion, a prima facie case of obviousness under 103(a) is not established for claim 32 because at least one element of claim 32 is not taught by Walker (‘240) or Walker (‘467), separately or in combination. Because a prima facie case of obviousness under 103(a) is not established for the claim 32, Appellants respectfully request allowance of 32, 39, and 46.

6. Claims 33, 40, and 47 are not obvious under Walker et al.

Claims 33, 40, and 47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Walker in view of Eitel et al. (US Patent 5,933,828). Applicants respectfully assert that because the independent claims 30, 37, and 44 upon which these dependent claims 33, 40, and 47, respectively, rely are not obvious in view of Walker, then the dependent claims 33, 40, and 47 are also not obvious in view of Walker and the dependent claims should be allowed.

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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,

 on 4/15/2005

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